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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,889	01/22/2001	Samuel Sergio Tenembaum		9326

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EXAMINER

DURAN, ARTHUR D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 03/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/765,889	TENEMBAUM, SAMUEL SERGIO	
	Examiner	Art Unit	
	Arthur Duran	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Claims 1-16 have been examined.

Election/Restrictions

2. Applicant's election without traverse of Group I, claims 1-16, in the reply filed on 2/15/2006 is acknowledged.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1, 8 recites the limitation "the Business". There is insufficient antecedent basis for this limitation in the claim. No Business has been established prior to the statement "the Business" in the claim. The claim can read "a Business" or something similar.

Claim 10 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 10, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Also, claim 10 is indefinite for being overly broad by stating, "is on any other". The word "any" makes the claim indefinite and overly broad.

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Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. The claimed invention of claims 1-16 is directed to non-statutory subject matter. The claims do not describe a useful process, machine, manufacture, or composition of matter nor do the claims produce a useful, concrete, and tangible result.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-6, 8, 9, 12-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Palcic (20030004809).

Claims 1, 8: Palcic discloses a method of granting Equity Rewards to Customers, the method comprising:

establishing an agreement between the Business that grants the Equity Rewards and the Customer that receives these Equity Rewards,

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establishing both a quantitative and a qualitative relationship between the purchase of goods or services that triggers the grant of Equity Rewards and the Equity Rewards themselves (Abstract; Paragraphs [34, 125]; Claims 13, 19, 23, 31; Fig. 1, 5, 6, 8).

Palcic further discloses establishing both a quantitative and a qualitative relationship between the Customer or Prospective Customer's interaction with the Business' advertising that triggers the grant of Equity Rewards and the Equity Rewards themselves (Paragraphs [5, 23]).

Claim 2, 12: Palcic discloses the method of claim 1., wherein the Business granting the Equity Rewards is a Public Company (Paragraph [22], "By this invention, an offering company grants a slice of its equity and stock to the consumer in correlation to the individuals consumer's patronage as measured by the consumer's consumption of products, services, and promotional alliance offerings of the offering company").

Claim 3, 13: Palcic discloses the method of claim 1., wherein the Equity Rewards are in the form of stock (Paragraphs [19, 125]).

Claim 4, 14: Palcic discloses the method of claim 1., wherein the Equity Rewards are in the form of Warrants or Stock Options (Paragraphs [19, 125]).

Claim 5, 15: Palcic discloses the method of claim 1., wherein the Equity Rewards are in the form of Bonds (Paragraphs [19, 125]).

Claim 6, 16: Palcic discloses the method of claim 1., wherein the Equity Rewards are in the form of Convertible Bonds (Paragraphs [19, 125]).

Claim 9: Palcic discloses the method of claim 8, wherein the Business advertising is on the Internet (Paragraphs [5, 16, 23]).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 7, 10, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palcic (20030004809).

Claim 7, 11: Palcic discloses the method of claim 1 and 8. Palcic does not explicitly disclose that the company is private. However, Palcic discloses that the Business granting the Equity Rewards can be a wide variety of types of companies and that the awards can be stock or goods and service other than stock or that promotional agreements with other companies can be made (Paragraph [22]). Notice in Paragraph [22] that the company can utilize other companies equity in promotions via promotional agreements. Also, notice that the company can be a utility provider or a gas and electric provider or a provider of a wide variety of goods and services that can be utilized in promotions.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add that Palcic's wide variety of companies can be a public company that is not publicly traded on the stock market. One would have been motivated to do this in order to better allow a wide variety of companies to be promoted.

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Claim 10: Palcic discloses the method of claim 8. Palcic does not explicitly disclose that the the Business advertising is on any other traditional media, such as newspapers, TV, Radio, Billboards, etc. However, Palcic discloses that the advertising can be general advertising (Paragraphs [5, “or even for paying attention to an Advertisement”]) and that the companies can be traditional media related companies (Paragraph[15]). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that Palcic’s advertising can be online or offline/”traditional”. One would have been motivated to do this in order to utilize differing advertising media that better reaches different users.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a) Kalina (6243688) discloses stock/equity/financial awards related to purchasing:

“(7) The parent application describes a method and system which fulfills this need. More specifically, the parent application is directed to describing methods and systems employing a purchase award account wherein purchase credit awards resulting from a purchase by a consumer using the purchase award account is converted into an ownership interest in an investment vehicle such as a stock, bond, mutual fund, money market fund, or insurance product. More specifically, a purchase credit award interchange center is described which interfaces with a credit award exchange center for converting any form of merchant or purchase credit award resulting from a customer purchase of goods and services into an interest in an investment vehicle. Pre-assigned purchase credit accumulations earned by the customer are exchanged from a merchant or creditor through a combination of credit card, co-branded credit card, PIN card, debit and smart cards, coupons, stamps, proof of purchases, rebates, or any other form of purchase award. In this manner, the customer accrues an interest in an investment vehicle, rather than merely earning a gift certificate, mileage award or the like.

(12) FIG. 2 illustrates an Internet-based method for establishing a credit card account or other purchase award account providing accrual of purchase

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credits exchangeable into stocks or other investment vehicles. At step 100, a central computer system such as the exchange system 20 of FIG. 1 displays information on an Internet web page describing the credit card account agreement. The web page also describes particular investment vehicles in which an award may be accrued using the account including, for example, stocks, bonds, mutual funds, money market fund, insurance products or real estate investments. The web page is accessible by the various potential applicants via any conventional web browser or the like. Preferably, links are provided on other web pages, such as merchant web pages, chat room web pages, affiliate marketing web pages and the like, to the Internet web page describing the credit card account agreement such that new potential customers will be directed to the account. Direct email to potential customers may also be employed to generate further customers”;

b)Feidelson (20020116264) discloses stock awards related to purchasing:

“[0005] Another investment-based customer award program is described in U.S. Pat. No. 5,233,514 to Ayyoubi et al. Ayyoubi et al. describe a customer loyalty program wherein customers receive credit towards the purchase of stock in a given company by sending in UPC labels from products that they have purchased from the given company. The entity collecting the UPC labels authenticates the UPC labels and maintains a computer account that accumulates the amount of credit the customer has earned. The file is kept such that when a customer has accumulated enough credit to purchase a share of stock in the given company, the entity purchases the share in the name of the customer”;

c) Goldhaber (5,794210) discloses providing rewards in electronic money or various other forms for a user interacting with advertising or for making a purchase;


d) Postrel (20040098317) discloses providing rewards in electronic money or various other forms including related to a companies stock for a user interacting with advertising or for making a purchase.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Arthur Duran
Primary Examiner
2/23/2006